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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,635	11/09/2001	Ilona Lange	H 3243 PCT/US	4995

23657 7590 03/25/2004

COGNIS CORPORATION  
PATENT DEPARTMENT  
300 BROOKSIDE AVENUE  
AMBLER, PA 19002

EXAMINER
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TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/857,635

**Applicant(s)**

LANGE ET AL.

**Examiner**

Philip C Tucker

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32 is/are allowed.
- 6) ☒ Claim(s) 11-15, 17, 18 and 20-26 is/are rejected.
- 7) ☒ Claim(s) 16, 19 and 27-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21, 22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. (4732213).

Bennett teaches a silica sol based fluid for consolidating soils which comprises a colloidal silica within the scope of the present invention (see claim 1). Bennett teaches that polycarboxylic acids within the scope of the present invention may be used in the silica sol (see examples 67-72).

3. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone (2281810).

Stone teaches an earth consolidation composition which comprises an aqueous silica sol and a phosphonic acid, which is used to consolidate earth (see claims).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (4732213) or Stone (2281810).

Bennett and Stone are taught above. Bennett and Stone differ from the present invention in that sequential addition of the silica sol and polycarboxylic acid or phosphonic acid is not disclosed. The courts have held that process steps taken concurrently are equivalent of steps taken successively (*Asbestos Shingle, Slate & Sheathing Co. vs. Rock Fiber Mfg. Co.* 217 F. 66). It would thus be obvious to one of ordinary skill in the art to use successive steps of adding the silica sol and then acids successively, instead of concurrently as taught in Bennett and Stone.

6. Claims 11-15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skee (6465403 B1).

Skee teaches a silica sol containing composition which comprises chelating agents, such as polycarboxylic acids (column 7, lines 39-55), having a particle size within the scope of the present invention (see example 19), which is used for cleaning. Skee differs from the present invention in that a specific example of a composition containing the sol and chelating agent at a level of 0.01 to 400 ppm is not disclosed. Skee however teaches that the chelating agent may be present at a level as low as 100 ppm. It would be obvious to one of ordinary skill in the art to make compositions of Skee with polycarboxylic acid chelating agents at a level as low as 100 ppm, given the teaching of Skee that such compositions are useful for cleaning.

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7. Claims 16, 19 and 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claim 32 is allowed over the art of record.

9. Applicant's arguments have been considered but are only deemed partially persuasive. A recalculation of the amounts of polycarboxylics in the invention of Bennett, shows that the amounts therein are an order of magnitude greater than the amounts of the present invention, thus the rejection of claim 11 and those dependent therefrom by Bennett is removed.

Applicant's arguments with regard to independent claim 21 is not deemed persuasive, with respect to both Bennett and Stone, since claim 21 does not teach a specific amount of claim stabilizer therein. Similarly, the dependent claims which do not teach the specified amounts of 0.1 to 400 ppm are not distinguished. With respect to the rejection under 35 USC 103 of claims 21 and 23 by Bennett and Stone, it is clear that the courts have held that steps taken concurrently and steps taken successively would be obvious variations to one of ordinary skill in the art (see Asbestos Shingle, Slate & Sheathing Co. vs. Rock Fiber Mfg. Co. supra). Applicant has not pointed to

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any deficient reasoning why the courts decision is improper. The rejection is thus maintained.

With respect to the rejection over Skee, applicant has argued that there is no motivation in Skee to use a combination of 2% by weight of silica with levels of 100 ppm chelating agent. The courts have held that "the fact that a specific embodiment is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments must be considered ", In re Lamberti 192 USPQ 278. Clearly one of ordinary skill in the art would be motivated to utilize all of the embodiments of Skee, including those with the silica as low as 2% and chelating agent as low as 100 ppm. The rejection is thus maintained.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

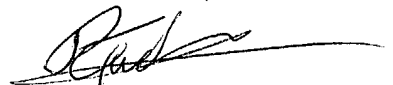
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip C Tucker  
Primary Examiner  
Art Unit 1712

PCT-2976